

**REMARKS**

In the December 24, 2003 Office Action, the Examiner noted that claims 2-60 were pending in the application and were rejected under the judicially created doctrine of double patenting and under 35 U.S.C. §§ 102(e) and 103(a). In rejecting the claims, U.S. Patents 6,230,192 to Roberts et al.; 5,774,666 to Portuesi (Reference AD); 5,744,664 to Hidary et al. (Reference BA) were cited. Claims 2-60 remain in the case. The Examiner's rejections are traversed below.

**The Application**

The subject application is directed to a method and system for enhancing the experience of consumers when playing back a recording using a computer or other device connected to a remote computer via a network. An identifier for the recording is sent from the local computer or device to a remote computer storing a database of recording identifiers and pointers to complementary content. In the disclosed embodiment the local and remote computers use hypertext markup language (HTML) or a similar protocol, and the database identifies the complementary content using uniform resource locators (URLs). As the recording is reproduced, i.e., played back, at the local computer or other device, data identified by the URL(s) is output using an output device incorporated in or associated with the local computer or other device.

The specification primarily refers to the recording as an audio compact disc (CD), but as described at the top of page 3, the term CD player includes playback devices that can playback a digital versatile disc (DVD) and similar media. Thus, the recording may be audio only, video only, or audio and video and may be stored on a removable disc, a fixed disk, a tape, semiconductor memory or other storage medium. The complementary content may be text, audio or graphics, including moving or motionless images. The remote data output based on playback of the recording or access to data at the local computer or device may be freely available, or restricted to those who have access to the recording or data, as described in the full paragraph on page 11 of the application.

**The Cited Art****U.S. Patent 6,230,192 to Roberts et al.**

The subject application is a continuation of the Roberts et al. '192 patent.

**U.S. Patent 5,774,666 to Portuesi**

The Portuesi patent is directed to a system and method for displaying uniform resource locators (URLs) embedded in a time-based medium. As illustrated in Figs. 2 and 3 and described at column 4, line 47 to column 6, line 19, movie file 8 includes audio track 16, image track 18 and associated URL track 20. The URL track 20 contains URLs 26 that are defined to be displayed with associated images in the image track 18, as illustrated in Fig. 3.

**U.S. Patent 5,744,664 to Hidary et al.**

The Hidary et al. patent is directed to an enhanced video programming system that displays retrieved integrated Internet information segments. As stated in the next to last sentence in the Abstract, "Web pages are synchronized to ... video content for display in conjunction with a television program being broadcasted to the user at that time." At the end of the specification, a modification to the system is described. "[I]nstead of receiving the video program from a transmission means, the video program can be addressed directly from the user site if the video program, with embedded URLs is stored on a VHS, Beta, DVD or other medium" (column 9, lines 3-7). In either case, the universal resource locators (URLs) or Web page addresses are "extracted from the vertical blanking interval" (column 8, lines 21-22), or in the case of broadcast signals "received directly via the Internet" (column 8, lines 22-23) when, as illustrated in Fig. 2, the broadcaster outputs the URLs as the broadcast signal is being generated. In the embodiment illustrated in Fig. 4 as described at column 5, line 47 to column 7, line 5, the URLs are separately transmitted from the broadcaster as in the embodiment illustrated in Fig. 2, but instead of being broadcast simultaneously with the video program, they are transmitted beforehand.

In the system taught by Hidary et al., e.g., "while the viewer is watching ... [a] music video, biographical information on the band can also be displayed adjacently to the video window" (column 8, lines 28-30). Regardless of whether the URLs are derived from the video program or received directly from the Internet as illustrated in Figs. 2 and 4, the local PC 16 (Fig. 2) "directs the JAVA enabled browser 98 to retrieve the particular relevant Web pages 102 and synchronizes the retrieved Web pages to the video content for display on the user's computer 16" (column 7, lines 25-28). Synchronization of the video and Web pages is accomplished when the Web pages "are optionally time stamped to be displayed on the computer screen when predetermined related video content is displayed in the video window" (column 7, line 67 to column 8, line 2). The only other mention of time stamps that has been found is that "the URLs

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have associated time stamps which indicate to the subscriber stations when, during the video program, to display the particular Web pages addressed by the URLs" (column 4, lines 53-55).

### **Double Patenting Rejection**

In item 2 on page 2 of the Office Action, claims 2-60 were rejected under the judicially created doctrine of double patenting. A Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(b) is submitted herewith. Therefore, withdrawal of the rejection is respectfully requested.

### **Rejection under 35 U.S.C. § 102(e)**

In item 4 on pages 3-4 of the Office Action, claims 2-60 were rejected under 35 U.S.C. § 102(e) as anticipated by Portuesi. Submitted herewith is a copy of the Declaration under 37 C.F.R. § 1.131 submitted July 6, 2000 in the parent application which issued as U.S. Patent 6,230,192 to Roberts et al. The Rule 1.131 Declaration establishes a date of invention earlier than the filing date of Portuesi. Therefore, withdrawal of the § 102(e) rejection is respectfully requested.

### **Rejection under 35 U.S.C. § 103(a)**

In item 7 on pages 5-6 of the Office Action, claims 2-60 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hidary et al. However, the description of what is taught by Hidary et al. in the Office Action does not include limitations recited in the independent claims and no suggestion of the features of the invention recited in those limitations has been found in Hidary et al.

Claims 2 and 37 recite "at least one storage location dynamically determined when the playback of the recording occurs" (e.g., claim 2, last 2 lines). As described above, Hidary et al. is directed to a system that receives URLs in conjunction with a video broadcast. As indicated in Figs. 1 and 2 and described at column 7, lines 20-38, the system taught by Hidary et al. requires that URLs be embedded in the recording or "entered by member TV broadcasters ... along with specified times for transmitting the URLs to the user" (column 7, lines 32-34). In both cases, the URLs are determined prior to the video broadcast. If the broadcast is of a recording (as required by the claims), the URLs would be determined prior to playback, not "when the playback of the recording occurs" (e.g., claim 2, last line). Nothing has been cited in Hidary et al. or any other prior art suggesting how URLs could be "dynamically determined when the playback of the recording occurs." Therefore, it is submitted that claims 2 and 37 and claims 3-12 and 38-40 which depend therefrom patentably distinguish over Hidary et al.

Claims 13 and 15 recite "automatically accessing the remote computer at a location dynamically determined after verification of access to the recording by the local computer" (e.g., claim 13, lines 5-6) and a similar limitation is recited in claim 33. First, Hidary et al. does not disclose a system that includes a computer accessing a recording. Second, as discussed above with respect to claims 2 and 37, nothing has been cited in Hidary et al. or any other prior art suggesting how URLs could be "dynamically determined". Therefore, it is submitted that claims 13, 15 and 33 and claims 16 and 34-36 which depend therefrom patentably distinguish over Hidary et al.

Claims 14, 17 and 25 include similar limitations. Claim 14 recites "a communication unit to automatically obtain remote data from the network upon access to the local data" (claim 14, lines 4-5). As noted in the preceding paragraph, Hidary et al. does not disclose a system that obtains data upon access to local data, but rather upon receipt of a URL either embedded in a broadcast signal or received separately during a broadcast. There is no accessing of local data that triggers obtaining remote data. Therefore, it is submitted claims 14, 17 and 25, as well as claims 18-24 and 26-32 which depend therefrom patentably distinguish over Hidary et al.

Claims 41-44 recite operations on "remote data obtained from the network upon verification of access by the local computer to a recording containing no content stored for the purpose of providing enhanced capability" (e.g., claim 43, lines 4-5). First, as noted above, Hidary et al. does not teach or suggest access by a local computer to a recording, but rather receipt of a broadcast signal that might be reproduced from a recording. Thus, there can be no verification of access to the recording locally. Second, Hidary et al. describes embedding the URLs in the recording or in association with the recording and thus, there **is** content stored for the purpose of providing enhanced capability at the remote location of the recording. Therefore, it is submitted claims 41-44 patentably distinguish over Hidary et al.

Claims 45, 49, 53 and 57 recite "determining an identifier from information associated with the recording ... [and] using the identifier as a key to locate at least one record in at least one database file" (e.g., claim 45, lines 2-4). Although the Office Action asserted that "a web page stored in the database server usually comprises additional related links to other web pages" (Office Action, page 6, lines 16-18), nothing was cited or has been found regarding the use of a database file to store a record that is accessed by a URL associated with the video program. Therefore, it is submitted claims 45, 49, 53 and 57 and claims 46-48, 50-52, 54-56 and 58-60 patentably distinguish over Hidary et al.

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**Information Disclosure Statement to Follow**

An Information Disclosure Statement will be filed shortly. If the Examiner has not received the Information Disclosure Statement by the time that the claims are reconsidered in light of this Amendment, the Examiner is respectfully requested to contact the undersigned by telephone to find out when the Information Disclosure Statement was filed.

**Summary**

It is submitted that Hidary et al. does not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 2-60 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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